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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,208	05/08/2001	Keiichi Nakajima	P-277852/NI-	6261
909	7590	11/03/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			GREENE, DANIEL L	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

3621

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,208

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,40,41,46,47 and 52-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,40,41,46,47 and 52-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The Examiner agrees with the Applicant's argument that the first and second terminals communicate with each other via the transaction apparatus. There is no indication in the specifications or the claims of one of the terminals controlling or instructing the other terminal. If such a claim is made, the Examiner requests that the Applicant specify page and paragraph in the Specifications that supports such a claim.

The Applicant further argues that neither Takayama nor Stein disclose that the first and second terminals are located at the same site. The Applicant considers the location of the two sites to be unique, original and non-obvious. The Examiner submits that the location of the two sites does not modify, affect and/or render that application unique, original or non-obvious because, the transfer of information during the transaction would occur regardless of where the two terminals were located.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to conduct the transaction regardless of where the two terminals are located because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Further, if in fact the location of the two terminals rendered the Application original and non-obvious, then a new Application could be generated that only changes the location of the devices being used and the Applicant's logic would prevail. Changing the location of the devices in relation to each other during a transaction does not advance the art or render an application original in concept, design and non-obviousness.

Claim Rejections - 35 USC § 112

2. The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

As per claim 1, the term "previously storing" as opposed to "storing" renders the claim into the past tense. Since the unique ID was "previously storing", it is no longer stored and available for use. Also, "stored in said transaction apparatus previously" does not claim it is stored in the transaction apparatus during the present transaction.

Allowable Subject Matter

As per Figures 1-3 and their respective descriptions in the Specification, the Examiner submits that what is unique, original and non-obvious is that the user terminal, (20), has two types of communications i.e. infrared (808) for communicating with the cashier terminal (10) via (708) and an antenna (800) for communicating to and through a carrier server to a settlement server (30). Note: By definition, infrared communication is line-of-sight only and therefore requires the transmitting and receiving units to have unobstructed i.e. line-of-sight view of each other. It would appear that the cashier provides the user terminal, via the infrared communication, the transaction ID and current information such that the user via his cellular phone, PDA or notebook type PC, can select how to pay using either his credit card or bank card and via the antenna, transmit the IDs to the settlement server to be processed.

Amendment of the pending claims to include the previous described features would render the claims allowable.

Claims 1-11, 40-41, 46-47 and 52-96 are pending.

Claims 12-39, 42-45, and 48-51 are cancelled.

Claims 52-96 are new.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-11, 40-41, 46-47, 52-96** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,332,133 *Takayama* in view of US 5,826,241 to Stein et al.

As per Claims 1, 3, 40-41, 46-47, 52, 62, 66, 72, 77, 78, 86, 90, 91, 95 and 96:

Takayama discloses the invention substantially as claimed including in a settlement apparatus performing a settlement of a transaction, which communicates with a billing terminal performing billing of the transaction and with a paying terminal performing paying of the transaction, the apparatus comprising:

a first terminal (Fig. 3, ele. 303) connecting to the communication network and having an information indicating unit (Fig. 3) and (Fig. 3, ele. 313);

a second terminal having a unique ID information and input unit, said second terminal being located at a same site as said first terminal and connectable to said first terminal through the communication network. (Fig. 1, ele. 104), (Fig. 1, ele. 100; Fig. 2A, 2B), and (Fig. 1, ele. 106); and

a transaction apparatus communicating with said first and second terminals through the communication network (Fig. 1, eles. 102, 103), said transaction apparatus storing said unique ID information of said second terminal (Col. 45, lines 16-22) said

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transaction apparatus setting up transaction ID information to be indicated on said indicating unit of said first terminal, said transaction apparatus receiving from said second terminal said second terminal said unique ID information of said second terminal together with said transaction ID information indicated on said information indicating unit of said first terminal and inputted through said input of said second terminal at the same site as said first terminal, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus. (Col. 71, lines 32-40).

Takayama does not specifically disclose that the transmission of the transaction identification number by the paying terminal is an element of synchronization. Stein discloses this limitation at Col. 7, line 33 to Col. 9, line 45, particularly Col. 8, lines 1-18. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Takayama with the transmission of a transaction identifier number because this would provide a uniquely generated identifier to facilitate confirmation that a transaction was valid. See Stein at Col. 7, lines 58-60 and Col. 8, line 37 to Col. 9, line 23 for support of this motivation. Note also that both references are directed to settlement of financial transactions; see Takayama at Title and Abstract, at least, and Stein at Col. 3, line 38 to Col. 4, line 8.

Concerning Claims 2 and 4, *Takayama* discloses that the first terminal communicates over a telephone line at Fig. 1, eles. 110,109. *Takayama* further

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discloses that the paying terminal connects to the settlement apparatus by radiotelephone communications at Col 43, line 59 to col. 44, lines 29.

Concerning Claim 5, *Takayama* discloses receipt of a purchase amount from a billing terminal for settlement at Col. 4, line 11 to col. 5, line 17. *Takayama* further discloses a settlement completion notification at Col. 11, lines 49-60 and a receipt to the paying terminal of a settled amount at Col. 52, lines 6-10.

Concerning Claims 6-7, *Takayama* further discloses unique identification of financial terminals and confirmation through such identification. Fig. 32 A-D.

Concerning Claims 8-10, *Takayama* discloses a purchase history at Col. 71, lines 26-58.

As per **Claim 11**:

Takayama further discloses:

that a billing unit (Fig. 4, ele. 403) in receipt of a transaction identifier (Fig. 2, Order Number) sends the transaction identifier (Fig. 7H) to a paying unit (Fig. 4, ele 400) which then forwards the transaction identifier to a processing unit (Fig. 404).

As per claim 53:

Takayama further discloses:

wherein said information indicating unit of said first terminal comprises a display or a speaker. Fig. 2A, 202.

As per claim 54:

Takayama further discloses:

wherein said first terminal is a terminal for a plurality of unspecified user and said second terminal is a unique terminal for the user. Fig. 3, Fig. 2A

As per claims 55, 56 and 84:

Takayama further discloses:

wherein the second terminal is a portable/ terminal/phone. Fig. 2A.

As per claims 57-61:

Takayama further discloses:

transaction apparatus that provides communications between the different entities of the transaction. Fig. 4.

As per claims 63, 67, 73, 79 and 92:

Takayama further discloses:

further comprising steps of inputting said unique ID information thereof from said input unit of said second terminal into transaction apparatus, and wherein said storing said unique ID information includes storing said transaction ID information in association with said unique ID information. Col. 4, line 11 to Col. 5, lines 17, Col. 11, lines 49-60.

As per claims 64, 69 and 74:

Takayama further discloses:

wherein the transaction system includes a plurality of first terminals and second terminals; and wherein said setting up the transaction ID information includes setting up a plurality of different transaction ID information each other, based on each instant of the current time, in accordance with each of instructions from each of said terminal. Col. 77, lines 1-67.

As per claims 65, 70, 75 and 93:

Takayama further discloses:

comprising a step of permitting said first terminal to perform a function and permitting said second terminal to perform another function, during the synchronization: Col. 93, lines 30-67.

As per claims 68, 71, 76, and 85:

Takayama further discloses:

wherein said processing unit synchronizes the communication with said first terminal and second terminal one-to-one. Col. 72, lines 25-46.

As per claims 80, 87, 88, and 94:

Takayama further discloses:

wherein said first terminal comprises an information indicating unit and wherein said transaction apparatus sends information including predetermined status in relation to the transaction to said first terminal, and said second terminal obtains said information including the predetermined status that is indicated by said information indicating unit from other than the communication network. Fig. 2A, Fig. 3 and Fig. 4.

As per claims 81, 82 and 89:

Takayama further discloses:

wherein the predetermined status includes information that a preparation to synchronize said first and second terminals has been completed. Col. 200, lines 40-67.

As per claim 83:

Takayama further discloses:

wherein said first terminal and said second terminal are located at the same site.

Fig. 2, 200 and Fig. 3, 301. Infrared devices require line-of-site communications i.e. both units must be in the same area with unobstructed line-of-site. Therefore it

would be obvious to one having ordinary skill in the art that the first and second terminals would be located at the same site.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

10/31/2005



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